

REMARKS

Applicants respectfully request reconsideration of the application, as amended, in view of the following remarks.

The present invention as set forth in **amended Claim 1** relates to a color toner composition comprising:

toner particles comprising:

a binder resin; and

a colorant and a release agent dispersed in the binder resin, and

0.3 to 1.5 parts by weight of titania as an external additive,

wherein the colorant has an average dispersion particle diameter not greater than 0.5 μm ;

the release agent and the binder resin are insoluble to each other;

the toner particles satisfy the following relationship:

$$0.05 \leq D_w/D_4 \leq 0.4,$$

wherein D_w represents an average dispersion particle diameter of the release agent and D_4 represents a weight-average particle diameter of the toner particles; and

the titania has a segregation rate of from 0.5 to 5 %.

None of the cited references disclose or suggest a color toner composition as claimed as claimed.

Anno et al uses in the Examples only 0.2 pbw of hydrophobic titania (Anno et al, col. 12, lines 53-55, col. 13, line 49, col. 14, line 8). Thus, the amount is much smaller than the claimed amount and in addition, the titania of this reference is surface modified. In addition, Anno et al fail to disclose or suggest the claimed rate of segregation of the toner.

Takezawa et al disclose a variety of toners at col. 4, lines 32-36. Titanium oxide is one of them. However, the claimed amount of titania is not disclosed or suggested.

Bertrand et al fail to disclose or suggest the claimed segregation rate. In fact, the segregation rate must be higher than 5% because a specific mixing method is used to control the segregation rate. In addition, this reference discloses a number of additives at col. 14, lines 35-50. This list fails to disclose the claimed titania having the claimed segregation rate in the claimed amount. In addition, Bertrand et al fail to disclose or suggest the solubility of the release agent and the binder, the particle diameter relationship of the release agent and the toner.

None of JP 11-258897 and Otani et al cure the defects of Bertrand et al as they fail to disclose or suggest the claimed titania having the claimed segregation rate and the claimed amount of titania. In addition, JP 11-258897 does not disclose the claimed particle diameter relationship of the release agent and the toner.

Kato et al and Eguchi et al also fail to cure the defects of Anno et al and Takezawa et al as they fail to disclose or suggest the claimed titania having the claimed segregation rate and the claimed amount.

Thus, even a combination of the cited references does not result in the claimed invention.

Therefore, the rejection of Claims 1, 3, 5, 7, 8, and 12 under 35 U.S.C. § 103(a) over Anno et al in view of Takezawa et al; the rejection of Claims 1, 3, 5-9 and 11-13 under 35 U.S.C. § 103(a) over Bertrand et al in view of JP 11-258897 and further in view of Otani et al; the rejection of Claim 2 under 35 U.S.C. § 103(a) over Anno et al in view of Takezawa et al and further in view of Kato et al; and the rejection of Claim 4 under 35 U.S.C. § 103(a) over Anno et al in view of Takezawa et al and further in view of Eguchi et al is believed to be unsustainable as the present invention is neither anticipated nor obvious and withdrawal of this rejection is respectfully requested.

The objection to the specification is obviated by the Amendment of the specification.

The Office has required restriction in the present application as follows:

Group I: Claims 1-8 and 11-13;

Group II: Claims 9 and 10;

Group III: Claims 14-20; and

Group IV: Claims 21 and 22.

Applicants affirm their provisional election, with traverse, of Group I, Claims 1-8 and 11-13.

Applicants traverse the Restriction Requirement on the grounds that the Claims of Groups II, III and IV include a toner as claimed in Claim 1 or are directed to a method of making the toner claimed in Claim 1. As such, the Groups should not be separated. In addition, if Claim 1 is found allowable, the non-elected Claims should be allowable as well.

Applicants respectfully traverse the Restriction Requirement on the grounds that no adequate reasons and/or examples have been provided to support a conclusion of patentable distinctness between the identified groups or shown that a burden exists in searching all the claims.

Moreover, the MPEP in §803 states as follows:

"If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement. Withdrawal of the Restriction Requirement is respectfully requested.

Finally, Applicants note that MPEP §821.04 states, "if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process

claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined." Applicants respectfully submit that should the elected group be found allowable, the non-elected claims 9 and 10 should be rejoined.

In addition, if Claim 1 is found allowable, the non-elected Claims should be allowable as well.

Turning to the Information Disclosure and Related Case Statements, as was pointed out to the Examiner during the discussion, the problem (in submitting unrelated references) arose due to a sincere effort on the part of Applicants and their U.S. Representatives to ensure that the duty of candor was satisfied. In the present case, the filing system for submitting these Related Case Statements resulted in the submission of several references that were apparently not related to the present invention. Applicants and their U.S. Representatives appreciate the Examiner's consideration of the submitted references and regret any difficulty caused by any submissions which were apparently not related to the present invention. As was pointed out during the discussion, however, the problem is more one of over-zealousness in satisfying the duty of disclosure rather than an attempt to "bury" any particularly material references. Indeed, as noted in the MPEP, "[i]t is desirable to call [copending applications belonging to the same applicant or assignee] to the attention of the examiner even if there is only a question that they might be 'material to patentability' of the application the examiner is considering." MPEP 2004-9. The MPEP also states that "[w]hen in doubt, it is desirable and safest to submit information. Even though the attorney, agent, or applicants doesn't consider it necessarily material, someone else may see it differently and embarrassing questions can be avoided" and further that "'the question of relevancy in close cases, should be left to the examiner and not the applicant.'" MPEP 2004-10, quoting *U.S. Industries v. Norton Co.*, 210 USPQ 94, 107 (N.D. N.Y. 1980) and *LaBounty Mfg., Inc. v. U.S. Int'l Trade Comm'n*, 22 USPQ2d (Fed. Cir. 1992). If Applicants or their Representatives erred, it was on

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the side of caution and in the interest of full disclosure. This is why the apparently unrelated references were submitted.

Applicants will submit copies of 09/713, 201 and 10/251,855 in a separate List of Related Cases.

This application presents allowable subject matter, and the Examiner is kindly requested to pass it to issue. Should the Examiner have any questions regarding the claims or otherwise wish to discuss this case, he is kindly invited to contact Applicants' below-signed representative, who would be happy to provide any assistance deemed necessary in speeding this application to allowance.

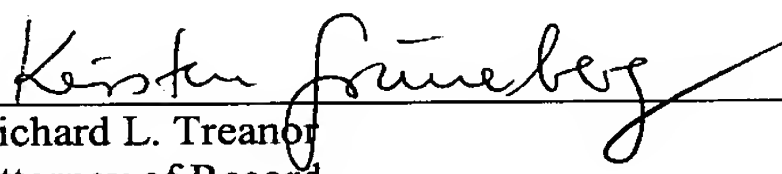
Respectfully submitted,

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